

REMARKS

The Office Action mailed December 7, 2009 has been reviewed and reconsideration of the above-identified application is respectfully requested in view of the following amendments and remarks.

Claims 1-16 are pending and stand rejected.

Claims 1, 6 and 11 are independent claims.

Claims 1-16 have been amended.

The Title is objected to for not being descriptive. Claim 6 is objected-to for including informalities. Claims 6-16 stand rejected under 35 USC 112, second paragraph as being indefinite. Claims 1, 4-6, 9-11 and 14-16 stand rejected under 35 USC 102(e) as being anticipated by Hirayama (USP no. 7,343,405). Claims 2-3, 7-8 and 12-13 stand rejected under 35 USC 103(a) as being unpatentable over Hirayama in view of Klemets (USP no. 7,451,229).

With regard to the objection to the Title, applicant respectfully disagrees and believes that a typographical error in the Title of the filed Preliminary Amendment has caused confusion. Thus, the current Title,

"COMPACT DISC PLAYING SYSTEM AND ITS PLAY BACK METHOD"
is believed to be sufficiently descriptive of the invention claimed.

Accordingly, no amendment to the Title is presented herein.

With regard to the objection to claim 6 and the rejection of claims 6-16 under 35 USC §112, second paragraph, applicant thanks the Examiner for his observation and has amended the claims to correct the errors noted.

For the amendments to the claims, applicant submits that the reason for the objection and rejection of the claims has been overcome and respectfully requests that the objection and rejection be withdrawn.

With regard to the rejection of claims 1, 4-6, 9-11 and 14-16 as being anticipated by Hirayama (USP no. 7,343,405) under 35 USC 102(e), applicant respectfully disagrees with, and explicitly traverses, the rejection of the claims.

However, in order to advance the prosecution of this matter, applicant has elected to amend the claims to recite the invention claimed in better form. More specifically, the independent claims have been amended to recite that the downloaded material is outputted or played in synchronization with the part of content stored on the disc. No new matter has been entered. Support for the amendment may be found at least on page 7, lines 18-26 ("[c]lip files, navigation information, playitems, and playlists stored on the network server 40 have one-to-one correspondence with those stored in the above optical disc10, in particular the address and clock information in the navigation information is entirely same as that in navigation information 10C of the optical disc10, **in order to synchronize the downloaded audio with video in the optical disc10 during playing.** In the network server 40, clip files of the audio information base 47B contain audio information to play the optical disc10 in coordination with the video information contained in clip files 10D of the optical disc10." (emphasis added).

In support of the rejection of the claims, the Office Action refers to Figures 1, 7 and 16 for teaching the elements recited in the claims.

As shown in Figure 7, Hirayama discloses a system wherein access is proved to a content server over a network and a request to the content server causes the content server to download data over the network (Internet). The downloaded data (which includes the desired content and any supplementary information) are stored in content storage unit or supplementary storage units, respectively, and when reproduction is required, a reproduction unit carries out the reproduction of the data from the content storage unit and/or the supplementary storage unit (see col. 6, lines 20-55). More specifically, Hirayama discloses that in the reproduction mode, "the reproduction unit retrieves the supplementary information attached to the contents in question from the supplementary information storage unit, reproduction location information

detected by the reproduction location detection unit and player information set in the player information setting unit. ... the reproduction information generation unit generates reproduction information based on the retrieved information." (see col. 6, lines 44-55).

Hirayama further discloses tracking and recording the number of times the downloaded information is reproduced for determining a pricing index based on the number of times the downloaded information is reproduced.

With reference to Figure 1, Hirayama more specifically discloses "[c]onnected to the Internet 2, the total download count computing system 11 receives from the content server 4 a notification that music contents have been downloaded to the player 3 and counts the total number of times the download has been carried out."

Hirayama discloses a system wherein the content (desired content and supplementary material) are provided from a download server which is then reproduced from the information stored in the storage units and the number of times the reproduction is performed is determined.

However, Hirayama fails to disclose that the information that is downloaded is reproduced in synchronization with a part of content which is stored on an optical disc. Rather, Hirayama discloses playing content that is totally downloaded from a server. Nowhere does Hirayama disclose that the information downloaded is played or outputted in synchronization with a part of content stored on an optical disc.

A claim is anticipated if and only if each and every element is recited in a single prior art reference.

In this case, Hirayama cannot be said to anticipate the subject matter recited in the claims, as Hirayama fails to disclose a material element recited in each of the independent claims.

For the remarks made herein, applicant submits that each of the aforementioned claims is not anticipated by the cited reference as the cited reference fails to disclose at least one material element of the claims.

Claims 2-3, 7-8 and 12-13 stand rejected under 35 USC 103(a) as being unpatentable over Hirayama in view of Klemets (USP no. 7,451,229).

Applicant respectfully disagrees with and explicitly traverses the rejection of the claims.

Each of the aforementioned claims depends from one of the independent claims, which have been shown to include subject matter not disclosed by Hirayama.

Klemets discloses a method of embedding content into a streaming media format and is cited for teaching the elements of the request including a language selected by the user.

However, Klemets fails to disclose playing downloaded material in synchronization with the part of content contained on an optical disc, as is recited in the claims.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations. However, the US Supreme Court in *KSR v. Teleflex* (citation omitted), held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in the *Graham v. John Deere* (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness).

In this case, the combination of the cited references fails to disclose at least one material element recited in each of the independent claims and thus, the combination of the cited references cannot be said to render obvious the subject matter recited in the aforementioned dependent claims.

For the amendments made to the claims and for the remarks made herein, applicant submits that the reason for the rejection of the claims has been overcome and respectfully requests that the rejections be withdrawn and a Notice of Allowance be issued.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at the telephone given below.

No fees are believed necessary for the timely filing of this paper.

Respectfully submitted,

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